REMARKS

Applicant respectfully requests reconsideration. Claims 1, 3-7, 11-13, 16-19 and 32-34 were previously pending in this application. By this amendment, claims 1, 11, 18 and 34 are being amended. No claims are being added or canceled. As a result, claims 1, 3-7, 11-13, 16-19 and 32-34 are pending for examination with claims 1, 11, 16 and 34 being independent claims. No new matter has been added.

Rejections under 35 U.S.C. §112

Claim 18 stands rejected under 35 U.S.C. §112, second paragraph because there is insufficient antecedent basis for "the first ablation electrode and the second ablation electrode". Claim 18 has been amended to recite "the first ablation electrode portion and the second ablation electrode portion". Withdrawal of this rejection of claim 18 is respectfully requested.

Rejections Under 35 U.S.C. §102(b)

Independent Claim 1

Claim 1 stands rejected under 35 U.S.C. §102 as being anticipated by U.S. Patent No. 5,234,429 to Goldhaber (hereinafter, "Goldhaber").

Claim 1 recites, among other limitations, an ablation electrode having an outer ablating surface, a first electrode portion and a second electrode portion. The electrode is convertible from a first configuration in which the electrode outer ablating surface has a first axial size to a second configuration in which the electrode outer ablating surface has a second axial size.

According to the Office Action, the electrode of Goldhaber has a first configuration in which operative tip (16) has a first axial size, and a second configuration in which operative tip (16) has a second axial size. To support this rejection, the Office Action points to Figs. 1 and 2, and column 2, lines 46-53. Column 2, lines 46-53 describe Fig. 1 as showing a cauterization electrode in a retracted configuration and Fig. 2 as showing the cauterization electrode in an extended configuration. In Goldhaber, the entire telescoping assembly (14) is described as being the "electrode" (see column 3, lines 3-12). Accordingly, the retracted and extended

configurations mentioned in the description of Figures 1 and 2 do not refer to the operative tip (16), which is the only exposed portion of electrode (14), but instead refer to the entire telescoping assembly. Therefore, this portion of Goldhaber does not teach a change in the axial size of an electrode outer ablating surface.

Additionally, in the specification, Goldhaber does not describe operative tip (16) of the embodiment of Figs. 1-3 as being movable. In the embodiment of Fig. 4, which is the only telescoping embodiment in which the connection the operative tip to the telescoping member is described, the operative tip (38) is described as being embedded in the distal end of a tubular member (40). Accordingly, one of ordinary skill in the art would not understand Goldhaber as teaching that the electrode has a first configuration in which the operative tip (16) has a first axial length and a second configuration in which the operative tip (16) has a second axial length.

Notwithstanding the above, and without acceding to the propriety of the rejection, claim 1 has been amended to recite that the first electrode portion has an outer ablating surface. The Office Action points to the leftmost telescoping tube (20) in Fig. 3 of Goldhaber as being a first electrode portion. The leftmost telescoping tube includes a layer (22) of electrical insulation, and therefore does not have an outer ablating surface, as recited in amended claim 1. Accordingly, withdrawal of the rejection of claim 1 over Goldhaber is respectfully requested.

Each of claims 4, 6, 7 and 33 depends either directly or indirectly from claim 1, and withdrawal of the rejections of these claims is respectfully requested for at least the same reasons provided above for claim 1.

Independent Claim 11

Claim 11 stands rejected under 35 U.S.C. §102(b) as being anticipated by PCT Published Application No. WO 95/20360 to Silvestrini (hereinafter, "Silvestrini"). According to the Office Action, Silvestrini teaches that that first electrode (2) has an outer ablating surface area length and an ablation electrode length which are adjustable because in one embodiment, an insulating sheath slides relative to the electrode and adjustably exposes a portion of the electrode, and in another embodiment, the electrode portions are slidable relative to one another.

Without acceding to the propriety of the rejection, claim 11 has been amended to recite that the ablation electrode has portions which stay in electrical contact with one another. In Silvestrini, second electrode portion (4) does not stay in electrical contact with electrode portion (2) because they are separate electrode portions (see page 10, lines 16-20 of Silvestrini). Consequently, the combination of first electrode portion (2) and second electrode portion (4) of Silvestrini cannot meet the limitation of an ablation electrode which has portions that stay in electrical contact with one another. And as separate electrodes, neither first electrode portion (2) or second electrode portion (4) has and adjustable length. The exposed outer surface area lengths are adjustable by sliding the insulation relative to the electrodes, but each electrode itself does not have an adjustable length. Accordingly, withdrawal of the rejection of claim 11 is respectfully requested for at least these reasons.

Each of claims 12 and 13 depends either directly from claim 11, and withdrawal of the rejections of these claims is respectfully requested for at least the same reasons provided above for claim 11.

Independent Claim 34

Claim 34 stands rejected under 35 U.S.C. §102(b) as being anticipated by Silvestrini.

Claim 34 recites an electrically conductive element which is convertible from a first configuration to a second configuration. Without acceding to the propriety of the rejection, claim 34 has been amended to recite that that in the second configuration, the electrically conductive element has a longer axial length as compared to the first axial length of the first configuration. While electrode portion (2) of Silvestrini has an adjustable exposed portion, the electrically conductive element itself does not change in length. Accordingly, withdrawal of the rejection of claim 34 is respectfully requested for at least this reason.

Rejections Under 35 U.S.C. §103(a)

Independent Claim 16

Claim 16 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Goldhaber in view of U.S. Patent No. 5,354,296 to Turkel (hereinafter, "Turkel").

Claim 16 recites, among other limitations, an ablation electrode comprising a first ablation electrode portion having an outer ablating surface, and a second ablation electrode portion having an outer ablating surface. Claim 16 further recites that the second ablation electrode portion is moveable from a first position substantially inside the first ablation electrode portion to a second position substantially outside the first ablation electrode portion.

According to the Office Action, Goldhaber discloses first and second electrode portions (two of the telescoping tubes 20 as labeled on page 10 of the Office Action), with the second ablation electrode portion being movable from a first position substantially inside the first ablation electrode portion to a second position substantially outside the first ablation electrode portion. The Office Action correctly notes that the first and second ablation electrode portions of Goldhaber do not have outer ablating surfaces because they are covered with insulation. To remedy this deficiency, the Office Action states that one of ordinary skill in the art would modify the Goldhaber device to remove the insulation because Turkel teaches a similar configuration of electrodes and to further vary the morphology and surface area of the electrode.

Applicant respectfully disagrees because the proposed modification of Goldhaber would render Goldhaber unsatisfactory for its intended purpose (see MPEP §2143.01(V)). Goldhaber states that the cauterization instrument is used to reach surgical sites located inside a patient – at times deep inside in a patient – so that an operative (16) can be brought into contact with organic tissue at the surgical site. When the surgical site is located deep inside a patient, telescoping tubes (20) are extended so that operative tip (16) can reach the surgical site for cauterizing or cutting the organic tissue (see column 3, lines 50-53).

The telescoping tubes of Goldhaber are used only to adjust the distance of the operative tip from the handle of the device (see column 3, lines 3-8). Goldhaber teaches that the intended purpose of the telescoping tubes is to closely match the length of the device with the distance to a

surgical site so that the operative tip (16) is brought into contact with organic tissue (see column 3, lines 42-49). If the telescoping tubes of Goldhaber were modified to lack insulation, the size of the effective outer ablating area would be dependent upon the distance of the surgical site within the body because if the telescoping tubes were to be fully extended to reach a deep surgical site, the uninsulated telescoping tubes would necessarily be exposed. Consequently, tissue that is proximal to the surgical site would be undesirably cauterized or cut by the telescoping tubes when the operative tip is actuated, rendering the device unsatisfactory for its intended purpose.

CONCLUSION

In view of the above amendment, applicant believes the pending application is in condition for allowance. A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, the Director is hereby authorized to charge any deficiency or credit any overpayment in the fees filed, asserted to be filed, or which should have been filed herewith to our Deposit Account No. 23/2825, under Docket No. B1075.71014US01 from which the undersigned is authorized to draw.

Dated: February 22, 2009

Respectfully submitted,

By _____

Eric L. Amundsen
WOLF, GREENFIELD & SACKS, P.C.
Federal Reserve Plaza
600 Atlantic Avenue
Boston, Massachusetts 02210-2206
617.646.8000